REMARKS

I. Introduction

Claims **1-15** are currently pending in the present application. Claims **1** and **14** are independent.

All claims stand rejected *solely* under 35 U.S.C. §102(e) as being allegedly anticipated by or alternatively under 35 U.S.C. §103(a) as being allegedly unpatentable over, U.S. Patent No. 6,980,886 (hereinafter "Shimoda").

Upon entry of this amendment, which is respectfully requested, claims **16-18** will be added. No new matter is believed to be introduced by this amendment.

Applicants hereby respectfully request reexamination and reconsideration of the pending claims in light of the amendments and remarks provided herein and in accordance with 37 C.F.R. §1.112.

II. The Examiner's Rejections

A. 35 U.S.C. §§102(e)/103(a) - Shimoda

Claims **1-15** stand *solely* rejected under 35 U.S.C. §102(e) as being allegedly anticipated by or alternatively under 35 U.S.C. §103(a) as being allegedly unpatentable over Shimoda. Applicants respectfully traverse this ground for rejection as follows.

1. No *Prima Facie* Case of Anticipation

The Examiner has simply and entirely failed to show how every element of the claims is taught or suggested by the cited reference.

> **a) The reference fails to teach or suggest**: *outputting a presentation which indicates the set of entitlement options, in which the presentation is output employing a game theme* (claims **1-13**)

Applicants respectfully assert that Shimoda simply fails to teach or suggest limitations of claims **1-13**. For example, Shimoda fails to teach or suggest *outputting a*

presentation which indicates the set of entitlement options, in which the presentation is output employing a game theme.

The Shimoda vending machine includes a prize dispensing mechanism attached to the vending machine, and prizes are dispensed from the hopper when they are 'won'. The Examiner appears to equate the prize dispensing mechanism of Shimoda to "outputting a presentation". Applicants respectfully assert that no reasonable interpretation of the term "outputting a presentation (indicating entitlement options)" could find equivalence with the prize dispensing mechanism of Shimoda. The prize dispensing mechanism of Shimoda is simply not a "presentation", nor is it "output" (indeed, it is attached).

Accordingly, at least because Shimoda fails to teach or suggest *outputting a presentation which indicates the set of entitlement options, in which the presentation is output employing a game theme*, Shimoda fails to anticipate claims **1-13**.

Applicants therefore respectfully request that this §102(e) ground for rejection of claims **1-13** be **withdrawn**.

b) The reference fails to teach or suggest: *receiving, from a customer via a vending machine, a selection of at least one of the set of entitlement options, thereby defining the at least one selected entitlement* (claim **3**)

Applicants believe that claim **3** is patentable at for depending upon a patentable base claim (*e.g.*, claim **1**) and at least for the reasons described herein.

Applicants further respectfully assert that Shimoda simply fails to teach or suggest limitations of claim **3**. For example, Shimoda fails to teach or suggest *receiving, from a customer via a vending machine, a selection of at least one of the set of entitlement options, thereby defining the at least one selected entitlement.*

Shimoda describes a switch that can be utilized to switch the vending machine from a prize dispensing mode, to a standard commodity vending mode (*e.g.*, switch 27). The Examiner equates this switch with the above-quoted limitation.

Applicants are at a loss as to how such an equivalence could be reasonably asserted. Initially, it appears from the description in Shimoda that the switch 27 is an

internal switch set by an operator of the vending machine (*e.g.*, and therefore not accessible to customers). Thus, anything received from the switch 27 **could not** be something received from a customer. Further, even if the switch 27 were accessible to customers, the switch does not effectuate a *selection of at least one of the set of entitlement options* (*thereby defining at least one selected entitlement*) as claimed.

Accordingly, at least because Shimoda fails to teach or suggest *receiving, from a customer via a vending machine, a selection of at least one of the set of entitlement options, thereby defining the at least one selected entitlement*, Shimoda fails to anticipate claim **3**.

Applicants therefore respectfully request that this §102(e) ground for rejection of claim **3** be **withdrawn**.

c) The reference fails to teach or suggest: *determining, based on profit inventory management data, a set of products that are available for dispensing by the vending machine* (claims **14-15**)

Applicants respectfully assert that Shimoda simply fails to teach or suggest limitations of claims **14-15**. For example, Shimoda fails to teach or suggest *determining, based on profit inventory management data, a set of products that are available for dispensing by the vending machine.*

The section of Shimoda cited by the Examiner to show support for anticipation of the above-quoted limitation has absolutely nothing to do with profit inventory management data. Nor does any other portion of Shimoda appear to contemplate such data much less determining products available for dispensing based on such data.

Accordingly, at least because Shimoda fails to teach or suggest *determining, based on profit inventory management data, a set of products that are available for dispensing by the vending machine*, Shimoda fails to anticipate claims **14-15**.

Applicants therefore respectfully request that this §102(e) ground for rejection of claims **14-15** be **withdrawn**.

d) No evidence to support rejection of many limitations

Applicants respectfully note that the Examiner has asserted that several limitations are anticipated by Shimoda without having cited any particular section of Shimoda as allegedly supporting such grounds for rejection. Applicants believe this is because no portion of Shimoda teaches, suggests, or renders obvious such limitations. Applicants note, for example, that the Examiner fails to support the rejections of the following claims and associated limitations with any evidence of record:

(i) *in which selecting at least one of the set of entitlement options comprises selecting at least one of the set of entitlement options without regard to any input that is received from a customer after receiving, from the customer, the selection of the product available for dispensing* (claim **5**);

(ii) *in which determining a set of entitlement options comprises determining a set of entitlement options based on profit inventory management data* (claim **7**);

(iii) *in which the at least one selected entitlement comprises at least one of: a discount on a product; a refund on a payment; a provision of at least one additional entitlement; a coupon; and an increase in a credit balance of the vending machine* (claim **10**);

(iv) *updating inventory data to reflect dispensed products* (claim **12**); and

(v) *in which outputting a presentation which indicates the set of entitlement options comprises: determining whether to output a presentation; and outputting the presentation in response to a determination to output the presentation* (claim **13**).

2. No Possible *Prima Facie* Case of Obviousness

The Examiner has failed to show how every element of the claims is taught or suggested by the cited references (alone or in combination) and the Examiner has entirely failed to address or consider (much less resolve) any of the requisite factual inquiries as set forth in *Graham v. John Deere*. Further, as the *fundamental basis* for the Office Action relies on §102(e), alleging that *all* claim limitations are taught by the cited

reference, the Examiner provides **no reasoning** why it would be obvious to modify the cited reference to teach missing limitations.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness.

a) No Reason to Combine is Evident

Even if the cited reference taught or suggested each limitation of claims **1-15** (which Applicants maintain is not the case), the Examiner has failed to establish a *prima facie* case for obviousness for any of claims **1-15**, at least because the Examiner has provided no argument, much less evidence (much less substantial evidence) that there would have been some reason for someone of ordinary skill in the art to modify the combined references to read on the pending claims.

Accordingly, at least because the Examiner has (i) failed to show how every limitation of claims **1-15** is taught or suggested, (ii) failed to provide a proper reason to combine the references, and (iii) failed to support any reason to combine by evidence on the record, the Examiner has failed to set forth a *prima facie* case for obviousness of claims **11-15**.

Applicants therefore respectfully request that these §103(a) rejections of claims **1-15** be **withdrawn**.

b) No Factual Inquiries Resolved

Applicants respectfully note that the factual inquires that must be resolved to establish a *prima facie* case of obviousness, as set forth in *Graham v. John Deere*, may be summarized as follows: (i) determine the scope and content of the prior art; (ii) ascertain the differences between the prior art and the claims at issue; (iii) resolve the level of ordinary skill in the pertinent art; (iv) and consider objective evidence (*e.g.*, secondary considerations).

Applicants further respectfully note that the Examiner has provided no evidence in support of a *prima facie* case for obviousness, nor has the Examiner resolved any of

the factual determinations required by *Graham v. John Deere*. Within such an evidentiary vacuum, there can be no *prima facie* case of obviousness.

At least for these reasons, the Examiner has entirely failed to establish a *prima facie* case for obviousness, and the §103(a) ground for rejection of claims **1-15** should therefore be **withdrawn**.

III. New Claims

New claims **16-18** are believed to be patentable over the cited references at least as described herein. Further, after reviewing the cited references, Applicants believe that none of the cited references, alone or in combination, teach, suggest, or render obvious at least:

(i) *providing, via the web site and as a result of the game, a benefit offer comprising (i) a redemption code, and (ii) an identification of at least one vending machine via which the redemption code may be entered to cause a dispensing of a benefit pursuant to the benefit offer* (claim **16**);

(ii) *outputting, by the vending machine and after the receiving of the indication of the selection of the desired product, a game-themed presentation comprising a game result that is indicative of a refund of the payment* (claims **17-18**); or

(iii) *determining, by the vending machine and based on an analysis by the vending machine of a status of the vending machine and stored profit management rules, to output the indication of the refund* (claim **18**).

IV. Conclusion

At least for the foregoing reasons, it is submitted that all pending claims are now in condition for allowance, *or in better form for appeal*, and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remain any questions regarding the present application or the cited reference, the Examiner is cordially requested to contact Carson C.K. Fincham at telephone number 203-438-6867 or via e-mail at cfincham@finchamdowns.com, at the Examiner's convenience.

V. Fees and Petition for Extension of Time to Respond

Enclosed herewith is the surcharge fee of **$220.00** for filing one (1) independent claim in excess of three (3).

Applicants also hereby petition for a **one-month extension** of time and authorize the charge of **$130.00** to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

Furthermore, should any other extension of time be required or any other fee be due, please grant any extension of time which may be required to make this Amendment timely, and please charge any required fee to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

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